



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

R2000-109

DEC 13 2000

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 11, 20, and 44 of the morning section and question 49 of the afternoon section of the Registration Examination held on April 12, 2000.

In the petition, petitioner requests the regrade of question 49 of **the afternoon section**. Petitioner, however, presents arguments for question 49 of **the morning section**. Since petitioner was given credit to the P.M. question 49, this decision assumes that the petitioner is requesting the regrade of A.M. question 49.

The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On July 24, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to

expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional point for morning question 20. Accordingly, petitioner has been granted an additional one point on the Examination. No credit has been

awarded for morning questions 11, 44 and 49. Petitioner's arguments for these questions are addressed individually below.

Morning question 11 reads as follows:

Please answer questions 10 and 11 based on the following facts. Mario Lepieux was a member of a Canadian national hockey team touring Europe. While travelling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999, without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in Moose Jaw Monthly, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the Moose Jaw Monthly article.

11. Which of the following statements is most correct?

- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C).

The model answer is choice (E).

Answer (E) is correct because Mario may rely on activities in both Germany (a WTO member country) and Canada (a NAFTA country) in establishing a date of invention prior to publication of the Moose Jaw Monthly article or in establishing priority. 35 U.S.C. § 104; see also MPEP § 715.01(c).

Petitioner argues that answer (A) is correct because answer (E) incorporates answer (C)

which is incorrect. Petitioner contends that the magazine article was published prior to the actual

reduction to practice occurred in Canada.

Petitioner's argument has been fully considered but is not persuasive. While the reduction to practice occurred after the date of publication of the article, Mario may rely on his activities in Canada in establishing his date of invention by showing due diligence after conception. See MPEP 715.07 and 35 U.S.C. § 104. Since the article is written by Mario and not a statutory bar, he may rely on his activity in Canada. See MPEP 715.01(c). Therefore, answer (E) is correct because statement in (C) is true. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 44 reads as follows:

44. Which of the following is not prohibited conduct for a practitioner under the PTO Code of Professional Responsibility?

- (A) Entering into an agreement with your client to limit the amount of any damages which your client may collect for any mistakes you make during prosecution of your client's patent application in exchange for prosecuting the application at a reduced fee.
- (B) Encouraging your client to meet with an opposing party for settlement discussions.
- (C) Failing to disclose controlling legal authority which is adverse to the client's interest when arguing the patentability of claims in a patent application.
- (D) In reply to an Office action, stating honestly and truthfully in the remarks accompanying an amendment that you have personally used the device and found it to be very efficient and better than the prior art.
- (E) Investing the funds your client advanced for your legal fees (not costs and expenses) in long term United States Treasury Bills in order to obtain guaranteed protection of the principal.

The model answer is choice (B).

Answer (B) is correct. See 37 C.F.R. § 10.87. As to (A), practitioner may not limit damages under 37 C.F.R. § 10.78. As to (C), see 37 C.F.R. § 10.89(b)(1). As to (D), see 37 C.F.R. § 10.89(c)(4). As to (E), see 37 C.F.R. § 10.112(a) where client funds advanced for legal services are required to be deposited in a bank account.

Petitioner argues that answer (D) is correct. Petitioner, however, marked the answer (E)

in the answer booklet of the Examination. Petitioner has not established that his chosen answer is the most correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 49 reads as follows:

49. Which of the following statements is NOT true?

(A) In representation of a client, a patent practitioner may not refuse a client's request that the practitioner aid or participate in conduct that the practitioner believes to be unlawful so long as there is some support for an argument that the conduct is legal.

(B) A patent practitioner may not form a partnership with a non-practitioner if any of the activities of the partnership consists of the practice of patent law before the PTO.

(C) In a patent case, a practitioner may take an interest in the patent as part or all of his or her fee.

(D) If a practitioner receives information clearly establishing that a client has, in the course of representation, perpetrated a fraud on the PTO that the client refuses or is unable to reveal, the practitioner must reveal the fraud to the PTO.

(E) A patent practitioner may not accept compensation from a friend of a client for legal services performed by the practitioner for the client, unless the client consents after full disclosure.

The model answer is choice (A).

37 C.F.R. § 10.84(b)(2) specifies that a practitioner may refuse to aid or participate in conduct the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal. Thus, statement (A) is FALSE. Statement (B) is TRUE. 37 C.F.R. § 10.49. Statement (C) is TRUE. 37 C.F.R. § 10.64(a)(3). Statement (D) is TRUE. 37 C.F.R. § 10.85(b)(1). Statement (E) is TRUE. 37 C.F.R. § 10.68(a)(1).

Petitioner argues that answers (B) is correct because the statement is false. Petitioner contends that in the event that the patent practitioner is an attorney, the practitioner may form a partnership with attorneys who are not patent practitioners or non-attorneys such as accountants

may only form partnerships with attorneys or other agents.

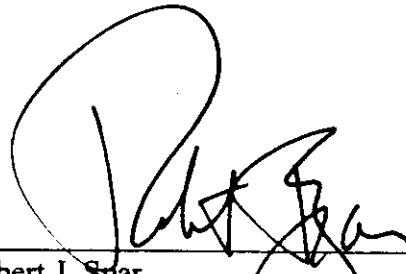
Petitioner's argument has been fully considered but is not persuasive. Statement in answer (B) is true because 37 CFR 10.49 states "[a] practitioner shall not form a partnership with a non-practitioner if any of the activities of the partnership consist of the practice of patent, trademark, or other law before the Office." No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read "Robert J. Spar", is written over a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy